

REMARKS

Claims 1-3, 6-20, and 25-40 are currently pending. Claims 28-36 and 38-40 are withdrawn. (The Office excluded claim 28 from its summary of the disposition of claims in the Office Action Summary). Claims 1-3, 6-20, 25-27, and 37 stand rejected under 35 U.S.C. §103 as unpatentable over WO 96/03113 ("WO '113") in view of Lambert et al., U.S. Patent No. 6,660,286 ("Lambert").

Reconsideration is respectfully requested of the rejection of claims 1-3, 6-20, 25-27, and 37 under §103(a) as unpatentable over WO '113 in view of Lambert.

Applicants respectfully repeat their assertion that the Office has not demonstrated that the claims are *prima facie* obvious, because there is no motivation whatsoever to combine the cited references. Indeed, the two references teach away from such a combination.

As previously noted, Lambert describes compositions that are "substantially ethanol-free." The compositions of WO '113, on the other hand, preferably comprise ethanol. See Amendment C dated April 15, 2005, pages 9-10. However, the Office found this argument unpersuasive "because instant claims do not recite the argued limitation and besides, omission of an element and its function is obvious if the function of the element is not desired." Applicants respectfully assert that whether a claimed invention is obvious in view of a combination of references requires, in part, the existence of some motivation to combine the references in the first place. If the absence of an element (e.g., ethanol) is required by one reference (e.g., Lambert) and the presence of that same element is preferred by another (e.g., WO '113), the motivation to combine these references is lacking. *Whether the claimed invention recites the element (in this case, ethanol or the lack thereof) is immaterial.* The question is whether there was a suggestion or motivation to combine WO '113 and Lambert. It is Applicants' contention that such a suggestion or motivation did not exist.

It is true, as the Office states, that WO '113 recites other solubilizers in addition to ethanol. Nevertheless, ethanol is identified as the preferred solubilizer, and indeed is present in every self-emulsifiable composition exemplified in WO '113 (see page 8,

lines 35-37; page 9, lines 19-25; Example 3, page 26; Example 6, page 30; Example 7, page 30; and Example 8, page 33). One of skill in the art would not have even considered combining a reference that specifically teaches away from ethanol (Lambert) with a reference that clearly prefers including ethanol (WO '113).

Furthermore, one of skill in the art would not have selected oleic acid or linoleic acid from the list of at least *sixteen* possible solubilizers described by WO '113, particularly in light of the clear preference for ethanol.

In light of the foregoing, Applicants assert that the Office has not shown that claims 1-3, 6-20, 25-27, and 37 are *prima facie* obvious in light of WO '113 in view of Lambert. Applicants submit that the present invention is now in condition for allowance. Early allowance of all pending claims is respectfully solicited.

Respectfully submitted,



Patricia K. Fitzsimmons
Registration No. 52,894

Pharmacia Corporation
Post Office Box 1027
St. Louis, MO 63006
Telephone: 314.274.1490
Facsimile: 314.274.9095

Enclosures:

Transmittal Letter
Combined Amendment Transmittal and
Request for Extension of Time
Itemized Postcard